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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/257,064	02/25/1999	TOSHIO ABE	35.C13352	1680

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LAMB, TWYLER MARIE

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/257,064

Applicant(s)

ABE ET AL.

Examiner

Twyler M. Lamb

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 1999.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-214 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-214 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-65 and 133-214 are drawn to an Information Processing Apparatus Comprising a Contour Information Extracting Means, a Layout Reference Information Setting Means and a Layout Means for Laying Out Printing Data, classified in class 35/, subclass 1.18.
 - II. Claims 66-107 are drawn to an Information Processing Apparatus Comprising a Determination Means for Determining an Output Destination for a Reverse Video Element, an Acquisition Means for Obtaining a Background Color and an Output Color Setting Means for Designating for Reverse Video Element a Color that Differs from a Background color, classified in class 358, subclass 1.9.
 - III. Claims 108-132 are drawn to an Information Processing Apparatus Comprising a Holding Means for Holding Specific Character Information, Extracting Means for Extracting Body Information for Characters and a Position Designation Means for Designating the Location of a Specific Character, classified in class 382, subclass 229.
2. The inventions are distinct, each from the other because of the following reasons: Inventions GI and GII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does

Art Unit: 2622

not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because GI is drawn to an Information Processing Apparatus Comprising a Contour Information Extracting Means, a Layout Reference Information Setting Means and a Layout Means for Laying Out Printing Data. The subcombination has separate utility such as GII is drawn to an Information Processing Apparatus Comprising a Determination Means for Determining an Output Destination for a Reverse Video Element, an Acquisition Means for Obtaining a Background Color and an Output Color Setting Means for Designating for Reverse Video Element a Color that Differs from a Background color.

3. Inventions GI and GIII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because GI is drawn to an Information Processing Apparatus Comprising a Contour Information Extracting Means, a Layout Reference Information Setting Means and a Layout Means for Laying Out Printing Data. The subcombination has separate utility such as GIII is drawn to an Information Processing Apparatus Comprising a Holding Means for Holding Specific

Art Unit: 2622

Character Information, Extracting Means for Extracting Body Information for Characters and a Position Designation Means for Designating the Location of a Specific Character.

4. Inventions GII and GIII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because GII is drawn to an Information Processing Apparatus Comprising a Determination Means for Determining an Output Destination for a Reverse Video Element, an Acquisition Means for Obtaining a Background Color and an Output Color Setting Means for Designating for Reverse Video Element a Color that Differs from a Background color. The subcombination has separate utility such as GIII is drawn to an Information Processing Apparatus Comprising a Holding Means for Holding Specific Character Information, Extracting Means for Extracting Body Information for Characters and a Position Designation Means for Designating the Location of a Specific Character.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 2622

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

Application/Control Number: 09/257,064

Page 6

Art Unit: 2622

Twyler Lamb

A handwritten signature in black ink, appearing to read 'Twyler Lamb', with a stylized flourish at the end.

January 29, 2003